

REMARKS

This is a full and timely response to the Office Action mailed May 3, 2005.

By this Amendment, the specification has been amended to correct a minor typographical error. Further, claim 1 has been amended to incorporate the limitation of claim 3 and to more particularly define the present invention. Thus, in view of the amendments to claim 1, claims 3, 4, 7, 10, 11, 14 and 15 have been canceled with prejudice or disclaimer to their underlying subject matter. Lastly, new claims 16 and 17 have been added to further protect specific embodiments of the present invention. Support for the claim amendments can be readily found variously throughout the specification and the original claims, see, for example, page 12 of the specification. Thus, claims 1, 2, 5, 6, 8, 9, 12, 13, 16 and 17 are currently pending in this application.

In view of these amendments, Applicant believes that all pending claims are in condition for allowance. Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

Rejections under 35 U.S.C. §102 and §103

On pages 2 and 3 of the Action, the recited claims, i.e. (a) claims 1-4 and 8-11 and (b) claims 1 and 3, are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Seiter (U.S. Patent 3,627,722) and Ito et al. (JP 2001-240844 A), respectively. Further, on pages 3 and 4 of the Action, the recited claims, i.e. (a) claims 12-15, (b) claims 5-7, and (c) claims 5 and 7 are rejected under 35 U.S.C. §103(a) as allegedly being obvious over Seiter, Seiter in view of Majolo et al. (DE 59 102 651), and Ito et al. in view of Majolo et al., respectively. With respect to claims 3, 4, 7, 10, 11, 14 and 15, these rejections have been rendered moot in view of the cancellation of these claims. With regard to claims 1, 2, 5, 6, 8, 9, 12 and 13, Applicant respectfully traverses these rejections.

To constitute anticipation of the claimed invention under U.S. practice, the prior art reference must literally or inherently teach each and every limitation of the claims. Further, to establish a *prima facie* case of obviousness, the prior art references must either alone or in combination teach or suggest the invention as a whole, including all the limitations of the claims. Here, in this case, none of the cited references, Seiter, Ito et al. and Majolo et al., either alone or in combination, teach or suggest the claimed limitation “*wherein the isocyanate group of the*

silyl group-denatured urethane prepolymer or the polyisocyanate compound bonds to a secondary or tertiary carbon atom except aromatic carbon atom”.

On page 12 of the specification, it is described “[I]n particular, the polyisocyanate having an isocyanate group bonded to a secondary carbon atom such as H₁₂ MDI (hydrogenated MDI); the polyisocyanate having isocyanate groups bonded to primary and secondary carbon atoms such as isophorone diisocyanate (IPDI), lysine diisocyanate, or lysine triisocyanate; and the polyisocyanate compound having an isocyanate group bonded to a tertiary carbon atom such as tetramethylxylylene diisocyanate (TMXDI) are preferable; the tetramethylxylylene diisocyanate is particularly preferable. The activity of the above isocyanate group is inhibited so that the storage stability of the first liquid is improved. Moreover, the composition obtained by mixing the above first liquid after the long-term storage with the second liquid described below is allowed to keep showing excellent curing property.”

When a highly active isocyanate group such as an aromatic isocyanate and a highly reactive methoxysilyl group are within one pack, methanol (which is generated by the hydrolysis with a very small quantity of water) readily reacts with and inactivates the isocyanate group. This is not preferable since the inactive isocyanate group is not reacted as a crosslink site. In contrast, the isocyanate of the present invention possesses low reactivity and thus has low reactivity with methanol, which results in the characteristics of no stickiness after curing.

Although Seiter describes isocyanates, the preferable example disclosed in Seiter is an aromatic diisocyanate as described in column 2, line 71, to column 3, line 11, of the reference. Other portions in Seiter also describe only an aromatic isocyanate. Thus, it is clear that Seiter does not teach or suggest “*an isocyanate compound having no aromatic ring and having the isocyanate group bonded to secondary or tertiary carbon atom while being excellent in storage stability*”.

Likewise, based on Applicant’s review thereof, the other cited references, Ito et al. and Majolo et al., also fail to teach or suggest “*an isocyanate compound having no aromatic ring and having the isocyanate group bonded to secondary or tertiary carbon atom while being excellent in storage stability*”.

Thus, since all of the cited references fail to teach or suggest the limitations “*wherein the isocyanate group of the silyl group-denatured urethane prepolymer or the polyisocyanate compound bonds to a secondary or tertiary carbon atom except aromatic carbon atom*” and

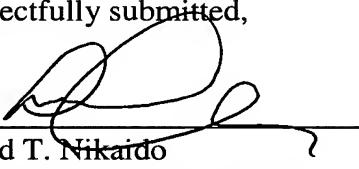
“wherein the activity of said isocyanate group is inhibited to improve the storage stability of said first liquid”, these rejections can no longer be sustained and should be withdrawn.

CONCLUSION

For the foregoing reasons, all the claims now pending in the present application are believed to be clearly patentable over the outstanding rejections. Accordingly, favorable reconsideration of the claims in light of the above remarks is courteously solicited. If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the below-listed number.

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Respectfully submitted,

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